

REMARKS

I. Status of the Claims

Claims 1-33, 38-82, and 87-102 are pending in this application and stand rejected. No claim has been amended or canceled in this paper.

Applicant respectfully acknowledges the Examiner's withdrawal of the rejection under 35 U.S.C. § 112, second paragraph in response to Applicant's Amendment filed March 22, 2004.

II. Rejection under 35 U.S.C. § 103(a)

The Examiner rejects claims 1-33, 38-82, and 87-102 under 35 U.S.C. § 103(a) as being unpatentable over Blankenburg et al. (WO 99/04750) ("Blankenburg") in view of Samain et al. (U.S. Patent No. 6,511,651) ("Samain") for the reasons set forth in the October 23, 2003, Office Action. See June 17, 2004, Office Action at 2.

The Examiner asserts that Blankenburg teaches "the use of polymers containing polysiloxanes for hair cosmetic formulations," and more specifically that "[a] water-dispersible polymer comprising ethylenically unsaturated monomers and polyalkylene oxide containing silicone derivatives." October 23, 2003, Office Action at 3. According to the Examiner, Blankenburg is deficient only in that it "lacks polyvinylpyrrolidone/vinyl acetate/vinyl propionate terpolymers, preferred cosmetic mediums, and preferred percent weight." *Id.*

The Examiner then cites Samain as teaching "an aerosol device comprising a container containing an aerosol composition, comprising a liquid phase containing a fixing material in a solvent and a propellant," where the "fixing materials are taught as

polymers containing vinyl lactam units, wherein polyvinylepyrrolidone/vinyl acetate/vinyl propionate terpolymers . . . as preferred polymers.” *Id.* at 4. The Examiner then concludes that it “would have been obvious to one of ordinary skill in the art at the time the invention was made to add polyvinylepyrrolidone/vinyl acetate/vinyl propionate terpolymers as taught by Samain et al. to the hair fixative composition of Blackenburg . . .” *Id.*

Applicant respectfully traverses the Examiner’s 103(a) rejection for at least the reason that Samain is not a valid reference under 35 U.S.C. § 103(c), and thus is not prior art to the claimed invention. M.P.E.P. § 706.02(I)(1). According to §103(c), subject matter developed by another, which was prior art only under 35 U.S.C. § 102(e), is now disqualified as prior art against a claimed invention filed on or after November 29, 1999, if that subject matter and the claimed invention “were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.”

The present application was filed after November 29, 1999 in the name of Christine DUPUIS alone. In contrast, the Samain patent has a different inventive entity. Thus, the subject matter of the claimed invention was clearly developed by another, as required under 103(c). In addition, while the application that resulted in Samain was filed on November 24, 1997, the patent issued on January 28, 2003, *i.e.*, after the filing date of the present application, and thus, can only be prior art against the present application under § 102(e).

Further, Samain is assigned to L’Oreal, as evidenced by the assignment information on the face of the patent, and was so assigned at the time the present

invention was made. The present application is also assigned to L'Oreal, as indicated by the executed assignment filed in this case and Notice of Recordation of Assignment, and was so assigned at the time the invention was made. Thus, both inventions were commonly owned at the time the present invention was made.

Finally, this statutory provision applies to any application filed on or after November 29, 1999. This last requirement is clearly met by the September 15, 2000, filing date of the present application. Accordingly, Samain is not prior art to the pending claims for the purposes of an obviousness rejection, and thus the outstanding rejection over the combination of Blankenburg and Samain is deemed moot. Even if Samain was prior art to the pending claims, the rejection is still improper because the Examiner has failed to make a prima facie showing of obviousness.

In order to establish a prima facie case of obviousness, the Examiner must, among other things, point to a suggestion or motivation within the references to modify or to combine reference teachings. M.P.E.P. § 2143. The Examiner has not shown that the cited references provide the requisite teaching or suggestion that would motivate the combination of the cited references. The Examiner attempts to support the allegation of obviousness on the following motivation argument:

- . . . a) Blackenburg [sic] and Samain et al. both teach hair care fixative compositions in the form of sprays;
- b) Samain et al. teach polyvinylpyrrolidone/vinyl acetate/vinyl propionate terpolymers as rigid enough to ensure that the hair is held in place and fragile enough for the user to be able to destroy the welds by combing or brushing the hair, without damaging the scalp or hair;

c) Blackenburg [sic] teaches that vinyl lactam homo and copolymers are known in the art as synthetic polymers that have been used for almost 50 years to strengthen hairdos;

d) Blackenburg [sic] teaches that other cosmetic agents can be added to his composition . . .

October 23, 2003, Office Action at 4-5. Not one of points a) through d) demonstrates a motivation to modify the cited references. In response to Applicant's previously filed remarks, the Examiner again states, "it is obvious to combine one hair fixative with another in the cosmetic art because of the expectation of enhanced fixation." June 17, 2004, Office Action at 3.

Applicant respectfully maintains that the fact that Blankenburg and Samain are both directed to fixative hair compositions does not provide a motivation for modification. It is not enough that references can be combined or modified -- this "does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." M.P.E.P. § 2143.01 (citing *In re Mills*, 916 F.2d 680 (Fed Cir. 1990)). Rather, relying on such statements is tantamount to an improper obvious to try rejection.

The Federal Circuit has held that even when combining the various components of a claimed composition may have been obvious to try, it does not constitute the standard for combining references under section 103, if the Examiner's rationale requires one to pick certain aspects that meet the claimed invention, while excluding the full teachings of the references. *In re Geiger*, 815 F.2d 686, 687, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987); *cf. In re Wesslau*, 353 F.2d 238, 241, 147 U.S.P.Q. 391, 393 (C.C.P.A. 1965) (holding "[i]t is impermissible within the framework of section 103 to

pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art").

This is especially the case in view of the teaching of Blankenburg with respect to vinyl lactams. In its discussion of the prior art uses of synthetic polymers for hairstyling, Blankenburg states that "[a]t first, vinyl lactam homopolymers and copolymers were preferred, **but subsequently polymers containing carboxylate groups have become increasingly important.**" Blankenburg translation at page 1 (emphasis added). Such a statement at the very beginning of Blankenburg's disclosure indicates that the invention of Blankenburg is a departure from, and alternative to, vinyl lactam copolymers. Thus, there is no suggestion or teaching that would motivate a person of ordinary skill in the art to subsequently combine the disclosure of Blankenburg, an alternative to vinyl lactam copolymers, with a nonionic polymer comprising at least one vinyl lactam. Finally, the fact that Blankenburg may teach that other cosmetic agents can be added to the composition, point d), does not constitute a suggestion to modify Blankenburg with the addition of vinyl lactams.

Indeed, absent an improper reliance on Applicant's disclosure, it is not clear how one skilled in the art would expect to achieve beneficial properties associated with the combination of claimed components considering that there is no teaching in either reference disclosing compatibility of the two compositions. There is no motivation between the two references to make such a selection, other than the Examiner's impermissible hindsight reconstruction. See *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984) ("The mere fact that the prior art could be so modified would not have made the

modification obvious unless the prior art suggested the desirability of the modification.”)
Nothing, other than Applicant’s disclosure, teaches or suggests a cosmetic composition comprising the claimed silicone/acrylate copolymer in combination with at least one nonionic polymer comprising at least one vinyl lactam unit chosen from polyvinylpyrrolidone/vinyl acetate/vinyl propionate terpolymers, of the claimed invention.

It is well-established law that the motivation to modify the prior art must flow from some teaching in the art that suggests ***the desirability or incentive to make the modification*** needed to arrive at the claimed invention. See M.P.E.P. § 2143.01; see, e.g., *In re Napier*, 34 U.S.P.Q.2d 1782, 1784 (Fed. Cir. 1995). In order to support a rejection under 35 U.S.C. § 103, therefore, “the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.” *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). The Examiner has not shown that either Blankenburg or Samain suggest the desirability of making the modifications necessary to achieve the presently claimed invention.

Thus, for at least the foregoing reasons, Applicant respectfully submits that the Examiner has failed to make a prima facie showing of obviousness, and requests the withdrawal of all rejections.

CONCLUSION


In view of the foregoing amendment and remarks, Applicant requests reconsideration of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: November 12, 2004

By: 
Deborah M. Sharfman
Reg. No. 52,211